ARGUMENTS/REMARKS

Applicant would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner has not indicated whether the drawings are acceptable. Furthermore the Examiner has not indicated whether the priority documents have been received. The Examiner is requested to do so.

Claims 1-24 remain in this application.

Applicant contests the finality of the current Office action. Applicant notes that at least some of the independent claims were amended in a previous amendment for editorial reasons only, and thus applicant's amendment could not have necessitated the new grounds for rejection of those claims. In particular, applicant points to claim 19, which had only editorial changes, in particular, adding the phrase "plurality of" to voltage controllers at line 8, in order to make it consistent with the terminology of line 6, and removing the redundant language "that controls said voltage control" of the last line, which merely repeats the language of lines 6-7. No amendments were made affecting the claim scope, and thus the new rejection of that claim could not have been necessitated by the amendments. Accordingly, the Examiner is requested to withdraw the finality of the Office action.

Claims 1-2 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Malkemes *et al.* (WO 97/40584) in view of Igarashi *et al.* (U.S. 5,926,749). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a step of "controlling an adjustable digital-to-analog converter for generating an analog baseband signal to be input to a modulator for frequency-converting a transmission signal to a signal in an IF band". Claim 13, as amended recites an "adjustable digital-to-analog converter for generating an analog transmission signal". Neither of the references teaches an adjustable D/A converter.

The Examiner points to the D/A converters 130 and 131 of Fig. 1, stating that they are controlled because they have "stages in a fixed fashion". However, the claims recite that the D/A

converter is "adjustable", and thus the reference, which teaches that the D/A converters are "fixed", teaches away from the solution. Thus, both claim 1 and 13 are patentable over Malkemes.

Igarashi does not overcome the Malkemes shortcomings. Furthermore, the Examiner has failed to provide the proper motivation for combining the references. The Examiner states that the motivation is to "provide an amplifier circuit suitable for a transmitter, which is capable of realizing a large dynamic range in a simple configuration, as taught by Igarashi". However, this is not a proper motivation.

The Examiner must provide a motivation for modifying the primary reference. Merely listing an advantage found in the secondary reference is not legally sufficient motivation, because this would make *any* secondary reference self-motivating for *any* primary reference, because every reference teaches some advantage that the Examiner could then cite. To make this legally sufficient motivation would mean that no new combinations of known features would be patentable, and this is clearly not the law.

To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to specifically modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the specific combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

Accordingly, the rejection for obviousness is not proper, and thus claims 1 and 13 are patentable over the references.

Claims 2 and 14, which depend on claims 1 and 13, respectively, are thus patentable over the references for at least the same reasons as the parent claims.

Furthermore, claim 2 recites that "a control ratio of the variable power amplifiers is modified" and claim 14 recites that "the variable power amplification control unit modifies a control ratio of the variable power amplifiers". The Examiner cites Malkemes as teaching these claim limitations, despite admitting that Malkemes does not teach the "plurality of variable amplifiers" of the parent claims. If the reference does not teach the element of the parent claims,

it can't teach a control ration associated with that element, either. Igarashi is also silent as to control ratios. Thus, claims 2 and 14 are patentable over the references for that reason as well.

Claims 7 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Malkemes in view of Fujita (EP 888,250 A2). For the following reasons, the rejection is respectfully traversed.

Claim 7 recites "controlling, using said plurality of voltage controllers, *a* power amplifier for amplifying a transmission signal via separate bias systems". Claim 19 recites "a plurality of voltage controllers for controlling *the* power amplifier via separate bias systems". The Examiner cites Fujita as teaching this limitation in Fig. 4, with items 7A and 26 representing the voltage controllers and items 24 and 25 representing the separate bias systems.

However, it is clear from Figure 4 of Fujita that bias system 24 is connected to amplifier 3, whereas bias system 25 is connected to amplifier 5. Similarly, controller 7A is connected to amplifier 1, whereas controller 26, although not connected to any amplifier, is connected to items 24 and 25, which are connected to amplifiers 3 and 4, respectively. Note particularly that there is no amplifier being controlled by a plurality of controllers. The claim language clearly requires that at least one amplifier have *multiple* controllers, which is not suggested by any of the references. Hence, the references do not teach the cited claim limitations, and thus claims 7 and 19 are patentable over the references.

Still further, the Examiner has not provided the proper motivation for combining the references, as discussed above, because merely listing a benefit of the secondary reference is not sufficient. Accordingly, the rejection for obviousness is not proper, and should be withdrawn.

Claims 3, 5-6, 8-9, 11-12, 15, 17-18, 20-21, and 23-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Malkemes in view of Igarashi, further in view of Fujita. Claims 4, 10, 16, and 22 are rejected as above in further view of Davidovici (U.S. 5,963,583). For the following reasons, the rejection is respectfully traversed.

Davidovici does not overcome any of the shortcomings of the other references discussed above, Hence, claims 3-6, 8-12, 15-17-18, 20-24, each depend on one of claims 1, 13, 7, or 19, and thus are patentable over the references for at least the reasons of their parent claims.

Furthermore, as discussed above, the Examiner has failed to provide the proper motivation for combining the references, again merely listing a conclusory, generalized benefit of the secondary references. Thus, the rejections for obviousness are improper, and thus claims are patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33677.

Respectfully submitted,

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February 2, 2005